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T-732 P.001/006 F-103

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TO: USPTO, Art Unit 1654, ATTN: Examiner Louise Leary  
DATE: May 5, 2003  
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SENT BY: Christine M. Hansen, Esq./Jean Marshall  
RE: Serial No. 09/736,051  
NUMBER CALLED: 8 00121 0254 9 1 703 308-4556  
CLIENT MATTER NUMBER: 121\*254

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COMMENTS:

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May-05-2003 12:40

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T-733 P.002/006 F-103

PATENT

Attorney Docket No. PC9344B (121\*254)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ke et al.

Serial No.: 09/736,051

Filed: December 13, 2000

For: COMBINATION THERAPY FOR  
OSTEOPOROSIS

Group Art Unit: 1654

Examiner: Leary, L.

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CERTIFICATE OF TRANSMISSION [37 C.F.R. 1.8(A) AND 1.6(D)]  
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING TRANSMITTED VIA FACSIMILE TO FAX NUMBER (703) 308-4556,  
PURSUANT TO 37 C.F.R. 1.8(A) AND 1.6(D), TO: COMMISSIONER FOR PATENTS, MAIL STOP AF, P.O. BOX 1450, ALEXANDRIA,  
VA 22313-1450, ON THIS 5TH DAY OF MAY 2003. (MONDAY)

BY:

*Max M. Marshall*

RESPONSE AFTER FINAL REJECTION

Applicants respectfully respond to the final Office Action mailed February 4, 2003.

Applicants thank the Examiner for noting that claims 1-4, 6-14, 16-30, 33-42, 45-50, 52-55, 57-62, 65-69, 72-75, 79-80, 84-89 and 92 are allowable over the prior art. Claims 93-108 remain rejected under 35 U.S.C. § 135 (b) as untimely. Applicants respectfully disagree with this rejection and request reconsideration for the following reasons.

Claims 93-108 are rejected for allegedly being filed in the PTO more than one year after issuance of US Patent 6,043,026. The '026 patent issued on March 28, 2000. Applicants added claims 93-108 in the Amendment Under 37 C.F.R. § 1.607 mailed on March 27, 2001. The

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Examiner accords the receipt date of March 29, 2001 as the date the claims were filed with the Patent Office. Yet Applicants are entitled to the mailing date of March 27, 2001 because that is the date that the claims were mailed to the PTO in compliance with the certificate of mailing provisions of 37 C.F.R. § 1.8.

Under 37 C.F.R. § 1.8, an Applicant is entitled to the date of mailing if the document includes a certificate of mailing :

37 CFR 1.8 Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated....

Here, Applicants complied with Rule 1.8 when submitting claims 93-108. These claims were submitted in an amendment mailed on March 27, 2001, before one year from the issuance of US Patent 6,043,026. That amendment included a certificate of mailing addressed as in 37 C.F.R. § 1.1(a) and deposited with sufficient postage as first class mail. Clearly, the document

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had sufficient postage as the Examiner admits that it was received on March 29, 2001, which is only two days after its mailing. Pursuant to 37 C.F.R. § 1.8 (a)(1)(ii), the amendment included a certificate stating that it was deposited on March 27, 2001 and was signed by a person having reasonable expectation that the amendment would be mailed on that date. The certificate was signed by Ms. Jean Marshall, an administrative assistant at Connolly, Bove, Lodge and Hutz. Ms. Marshall personally signed the certificate and deposited the amendment with the mailroom personnel at Connolly Bove Lodge and Hutz, with the reasonable expectation that they would follow their standard, daily procedure and deposit the amendment with the other outgoing mail with the US Postal Service before the end of the day. Thus, because the procedures of 37 C.F.R. § 1.8 were followed, Applicants respectfully submit that the claims required to be filed by March 28, 2001 were timely filed by their mailing on March 27, 2001.

The Office Action asserts that Applicants must provide the US Patent Office with "a certified copy of the certificate of mailing issued by the US Postal Office" on March 27, 2001 or March 28, 2001 (page 2). No statutory or regulatory support for this requirement is cited in the Office Action, and Applicants know of no such support. Furthermore, the Office Action faults Applicants for not providing "official evidence" that the amendment was filed with the US Postal Service prior to expiration of the set one year time period (page 2). Yet the only evidence required under the regulations is the properly addressed, dated and signed certificate of mailing, which was provided with the original signature with the amendment. Applicants respectfully

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submit that a statement from the US Postal Service or other evidence beyond the signed certificate of mailing is not required to be accorded the mailing date under 37 C.F.R. § 1.8.

Section 512 of the MPEP provides that when a paper is received in the U.S. Patent and Trademark Office after the end of the period for reply, the paper should be inspected to determine if a certificate of mailing or of transmission has been included. In those instances where a certificate of mailing or of transmission does appear in the paper, a check should be made to determine whether the indicated date of deposit or transmission is within the period for reply. If the date indicated in the certificate is after the end of the period for reply, the paper is untimely and no notation of the date need be made. Where the date indicated on the certificate is within the period for reply, the paper should be considered to be timely filed.

Here, the amendment has a certificate of mailing with an indicated date of March 27, 2001. Because this date is it is within one year of issuance of the '026 patent, the amendment is within the period for compliance with 35 U.S.C. § 135 (a). Accordingly, under the MPEP, a check of the date on the certificate of mailing should be all that is required by the Examiner before accepting the document as timely filed.

For these reasons, Applicants respectfully request that the rejections be withdrawn and that an interference be declared between the present application and the '026 patent and any continuing or divisional application thereof.

No fee is believed due for the filing of this paper. If the undersigned is mistaken,

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however, please charge any fee due or credit any refund to deposit account 03-2775.

Respectfully submitted,

CONNOLLY BOVE LODGE & HUTZ LLP

Dated: May 5, 2003

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